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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,996	04/05/2002	Tatsuji Nagaoka	9683/112	5819

7590

01/13/2006

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EXAMINER

LE, KHANH H

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,996

Applicant(s)

NAGAOKA ET AL.

Examiner

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Detailed Action

1. This Office Action is in response to the Amendment and Response, received September 6, 2005. Claims 18-52 are presented for examination. Claims 1-17 are canceled. Claims 18, 31 and 43 are independent. The previous rejections are withdrawn and new prior art is applied.

Claim objections

2. Claim 47 is repeated twice. Thus the second claim 47 to claim 52 are relabeled as 48 to 53 for examination purposes. It is required that Applicants renumber the claims as such in the next response.

Claim Rejections - 35 USC § 112 Second Paragraph

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 26, 39, 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

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As to claims 26, 39, 50 it is not clear how “the incentive information from the management system” can comprise “a request for the service from the service facility”. From a conversation with Mr. Tadashi Horie, Applicants’ representative, on January 4, 2006, it is agreed for examination purposes, to interpret these claims to mean that the incentive information comprise incentives for a free service that can be requested of the service facility. Applicants are to point out to specific support for this limitation and appropriate corrections are required to specifically claim as interpreted above.

Interpretation

5. As to claims 43-44 , the receiver in the preamble of claim 43 is interpreted to be different from the “user request receiver”. This latter is part of the management system, according to Mr. Tadashi Horie, Applicants’ representative, on January 4, 2006.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 18-22, 24-25, 27-28, 31-35, 37-38, 40-41, 43-47, 49, 51-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Crosby et al. US 6628928 B1 hereinafter Crosby.

As to claims 18, 31, 43, Crosby implicitly and explicitly discloses:

A mobile terminal (Fig.2. item 122 and associated text)

for use in a broadcasting system comprising a receiver (Fig.2. item 116)

for receiving broadcast information from the broadcast station (see , abstract, Fig.1 and associated text) and a management system (see Fig. 1 item 110: network operations center), the mobile terminal comprising:

receiver interface (see abstract: Interface to receive radio broadcasts; Fig. 2 and associated text) that communicates with the receiver to receive the broadcast information from the receiver,

user interface (see at least abstract; col. 12 line 65 to col. 13 line 2: keypad) that interacts with a user of the mobile terminal to generate a user request in relation to the broadcast information , wherein the user request is receivable

by the management system so that the mobile terminal receives from the management system incentive information for promoting a service (see at least Fig. 6 and associated text: coupons and other ads etc; col. 4 lines 11-26, 42-45; col. 6 lines 35-38: immediate transactions after receiving coupons, ads); and

mobile communication network interface (e.g. PDA's, (see col. 6 line 18) or integrated in the vehicular mobile unit , (see col.11 lines 5-10)) that communicates via a mobile communication network (see Fig. 1 item 111: internet) with a service facility that provides the service in order to receive the service from the service facility (see Fig. 6 and associated text: user connects to e-commerce sites provided to conduct service transactions).

Crosby also implicitly and explicitly discloses

A method for distributing service incentive information to a mobile terminal in a broadcasting system, comprising the steps of:
communicating with a receiver to receive broadcast information from the receiver',
interacting with a user of the mobile terminal to generate a user request in relation to the broadcast information, wherein the user request is receivable by a management system so that the mobile terminal receives from the management system incentive information for promoting a service; and
communicating via a mobile communication network with a service facility that provides the service in order to receive the service from the service facility (see cites above) .

Crosby also implicitly and explicitly discloses:

A management system for distributing service incentive information to a mobile terminal in a broadcasting system comprising a receiver for receiving broadcast information from the broadcast station, comprising:
user request receiver (Fig 3 item 206:wireless signal receiver) that receives a user request which is generated by a mobile terminal in relation to the broadcast information the mobile terminal receives from the receiver,
incentive information generator responsive to the user request to generate incentive information for promoting a service (such generator is implicit in Fig. 6 and associated text: coupons and other ads etc...)
; and
incentive information transmitter that transmits the incentive information to the mobile terminal so that a user of the mobile terminal uses the incentive information

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when receiving the service from a service facility via a mobile communication network (Fig. 6 and associated text: coupons and other ads etc...).

As to claims 19, 32, 44, Crosby discloses wherein the user request is sent to the management system via the receiver (internet device is integrated in the vehicular mobile unit , (see col.11 lines 5-10).

As to claims 20, 33, 45 Crosby implicitly discloses wherein the incentive information is received by the receiver interface via the receiver (internet device is integrated in the vehicular mobile unit, (see col.11 lines 5-10) and user receives incentives via the internet interface (Fig. 6) and implicitly uses the interface and the coupons provided for further transactions via the integrated internet-linked mobile unit).

As to claims 21, 34, 46 , CROSBY discloses wherein the incentive information is received by the mobile communication network interface (PDA or integrated mobile unit) via the mobile communication network (see at least Figs.1-6 and associated text).

As to claims 22, 35, 47 , CROSBY discloses wherein the user request is sent to the management system by the mobile communication network interface (PDA or integrated mobile unit) via the mobile communication network (see at least Fig. 1, item 106, 108 and associated text: radio satellites system).

As to claims 24, 37, 49 CROSBY discloses a memory (see at least Fig. 3 item 205 and associated text)for storing personal information, wherein the personal information is communicated to the management system (see at least col.3 lines 38-44), along with the user request (see at least col. 11 lines 17-35).

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As to claims 25, 38 CROSBY discloses wherein the user request comprises a form (see at least Fig.7 and associated text; col. 10 line 30 to col. 11 line 10; webpage as a form that a user can manipulate), and the user interface comprises a keypad for inputting data (see at least col. 12 line 65 to col. 13 line 2) into the form.

As to claims 27, 40, 51 CROSBY implicitly discloses wherein the incentive information from the management system comprises a redeemable promotion for the service from the service facility (see at least Fig. 6, coupons are provided then links to e-commerce sites are provided implicitly to use the coupons thereat ; see col. 4 lines 24-26, 42-45; col. 6 lines 35-38).

As to claims 28, 41, 52, and 53 CROSBY discloses wherein the user request comprises a qualification for the incentive information. (Fig. 7 and associated text: shows a webpage where coupons are available to users if the users select them. By merely selecting a coupon on the webpage, the user makes herself qualified (i.e. meeting the requirements) to receive the coupon or incentive in sending the request.) In CROSBY, the incentive information generator implicitly determines, based on the qualification (i.e. whether the user selects the coupon or not) , if the user qualifies for the incentive information.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 23,26, 29, 36, 39, 42, 48 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crosby in view of Meyer at al., US 6915271, herein Meyer.

As to claims 23, 36, 48, Crosby does not specifically disclose but Meyer discloses wherein the broadcast information comprises a network address of the management system , and the mobile communication network interface sends the user request to the network address (see at least col. 7 lines 42-54). Thus it would have been obvious to one skilled in the art at the time the invention was made to add such network addresses as taught by Meyer to Crosby to allow pointing to the whereabouts in the network of the processing site to facilitate processing (Meyer, col. 7 lines 42-54).

As to claims 26, 39, 50, CROSBY does not specifically disclose the incentive information from the management system comprises incentives for a free service that can be requested of the service facility. However CROSBY discloses coupons and access to e-commerce sites for immediate transactions (see at least Fig . 6 and associated text; col. 4 lines 11-26, 42-45; col. 6 lines 35-38: request for transaction service). Further Meyer discloses free products or services obtainable on or off -line (col. 7 line 38) to entice consumers to try new products or services. Thus it would have been obvious to one skilled in the art at the time the invention was made to add such incentives for free goods/ services as taught by Meyer that can be requested of the service facility to the Crosby system to allow the users to try new goods/services.

As to claims 29, 42, Crosby does not specifically disclose but Meyer discloses online redemption of e-incentives by communicating at least a part of the incentive information to the service facility, after receiving the incentive information, by the mobile communication network interface, via the mobile communication network in case a mobile user device such as an intelligent telephone is used. (see abstract, Figs 1-3 and associated text, col. 18 lines 1-18). It would have been obvious to one skilled in the art at the time the invention was made to add the above teaching of Meyer to Crosby to allow efficient online redemption since Crosby teaches e-coupons are provided.

Alternative Rejection

10. Claims 18-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Meyer et al., US 6915271.

As to claims 18, 31, 43, Meyer implicitly and explicitly discloses:

A mobile terminal (Fig. 1 item 115, consumer device, and associated text; col. 18 lines 34: TV set –top box or intelligent telephone or any combination of multiple computers) for use in a broadcasting system comprising a receiver (Fig.1. item 115: col. 18 lines 34: TV set –top box or intelligent telephone or any combination of multiple computers) for receiving broadcast information from the broadcast station (see , abstract, Fig.1 and associated text) and a management system (see Fig. 1 item 105: incentive information computer), the mobile terminal comprising: receiver interface (inherent in the user computer) that communicates with the receiver to receive the broadcast information from the receiver,

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user interface (inherent to permit clipping coupons , see Fig 2 and associated text) that interacts with a user of the mobile terminal to generate a user request in relation to the broadcast information , wherein the user request is receivable by the management system so that the mobile terminal receives from the management system incentive information for promoting a service (see at least abstract; Figs. 1-2 and associated text: coupons and other ads etc; transactions after receiving coupons, ads); and
mobile communication network interface (inherent to support intelligent telephone systems connected to the internet, see col.18 line 6) that communicates via a mobile communication network (inherent to support intelligent telephone systems connected to the internet, see col.18 line 6) with a service facility that provides the service in order to receive the service from the service facility (see Fig. 1, item 117 and associated text: user connects to e-commerce sites provided to conduct service transactions).

Meyer also discloses:

A method for distributing service incentive information to a mobile terminal in a broadcasting system, comprising the steps of:
communicating with a receiver to receive broadcast information from the receiver,
interacting with a user of the mobile terminal to generate a user request in relation to the broadcast information, wherein the user request is receivable by a management system so that the mobile terminal receives from the management system incentive information for promoting a service; and
communicating via a mobile communication network with a service facility that provides the service in order to receive the service from the service facility (see cites above).

Meyer also implicitly and explicitly discloses:

A management system for distributing service incentive information to a mobile terminal in a broadcasting system comprising a receiver for receiving broadcast information from the broadcast station, comprising:

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user request receiver (see col. 18 lines 1-18; Fig 3) that receives a user request which is generated by a mobile terminal in relation to the broadcast information the mobile terminal receives from the receiver,
incentive information generator responsive to the user request to generate incentive information for promoting a service (such generator is implicit in Fig. 3 and associated text: coupons and other ads etc...)
; and
incentive information transmitter (such transmitter is implicit in Fig. 3 and associated text) that transmits the incentive information to the mobile terminal so that a user of the mobile terminal uses the incentive information when receiving the service from a service facility via a mobile communication network (Fig. 3 and associated text).

As to claims 19, 32, 44, Meyer discloses wherein the user request is sent to the management system via the receiver (internet device is intelligent telephone :see col.18 lines 1-18).

As to claims 20, 33, 45 Meyer discloses wherein the incentive information is received by the receiver interface via the receiver (internet device is intelligent telephone :see col.18 lines 1-18) and user receives incentives via the internet interface (Fig. 3) and implicitly uses the interface and the coupons provided for further transactions via the internet-linked mobile unit.

As to claims 21, 34, 46 , MEYER inherently discloses wherein the incentive information is received by the mobile communication network interface via the mobile communication network (see at least col.18 lines 1-18; Figs.1-3 and associated text).

As to claims 22, 35, 47 , MEYER implicitly discloses wherein the user request is sent to the management system by the mobile communication network interface (see at least col.18 lines 1-18; Figs.1-3 and associated text).

As to claims 23, 36, 48, Meyer discloses wherein the broadcast information comprises a network address of the management system , and the mobile communication network interface sends the user request to the network address (see at least col. 7 lines 42-54).

As to claims 24, 37, 49, MEYER discloses a memory (see at least Fig. 2 item 211 and associated text) for storing personal information, wherein the personal information is communicated to the management system (see at least col.6 lines 44-66), along with the user request (see at least Fig. 2 and associated text).

As to claims 25, 38, MEYER discloses wherein the user request comprises a form (see at least Figs.7-10 and associated text; col. 8 line 38 to col. 10 line 62; webpage as a form that a user can manipulate), and the user interface comprises a keypad for inputting data (inherent in intelligent user device) into the form.

As to claims 26, 39, 50, Meyer discloses the incentive information from the management system comprises incentives for a free service that can be requested of the service facility (see at least col. 7 line 38).

As to claims 27, 40, 51 MEYER implicitly discloses wherein the incentive information from the management system comprises a redeemable promotion for the service from the service facility (see at least abstract; Figs. 1-3, coupons are provided then links to e-commerce sites are provided implicitly to use the coupons thereat)

As to claims 28, 41, 52, MEYER discloses wherein the user request comprises a qualification for the incentive information. (Fig. 2, item 205 and associated text: shows a webpage where coupons are available to users if the users select them and based on consumer data). In MEYER, the incentive information generator determines, based on the qualification if

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the user qualifies for the incentive information (Fig. 2, item 205 and associated text: shows a webpage where coupons are available to users if the users select them and based on consumer data).

As to claims 29, 42, Meyer discloses online redemption of e-incentives by communicating at least a part of the incentive information to the service facility, after receiving the incentive information, by the mobile communication network interface, via the mobile communication network in case a mobile user device such as an intelligent telephone is used. (see abstract, Figs 1-3 and associated text, col. 18 lines 1-18).

As to claim 30, Meyer discloses wherein the receiver comprises a set-top box, and the receiver interface comprises a set-top box interface (see at least col. 18 lines 1-18).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hara et al, US 5832223 A, discloses a broadcast signal that contains a URL associated with a product/service/program and returns information associated with such product/service/program by using such encoded URL. (col 2 l. 11-22, Figs 2-4 and associated text, col 2, l. 46-65, col 3 l. 29-30; col3 -col 4 l. 42) .

Holman, US 5287181 A, discloses Electronic redeemable coupon system and television.

Gacek, US 6795205, discloses 3rd-party authorization for home base printing involving wireless networks.

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Krishan et al, US 6442529, discloses internet delivery of targeted information.

Jovicic et al, US 5855007, discloses e-coupon communication system.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 3, 2006

KHL
KHL

Raquel Alvarez
RAQUEL ALVAREZ
PRIMARY EXAMINER